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PATENT
Customer No. 22,852
Attorney Docket No. 07937.0002-06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Samuel BENDINELLI et al.) Group Art Unit: 2182
)
Application No.: 09/832,345) Examiner: Fleming, Fritz M.
)
Filed: April 11, 2001)
)
For: METHODS AND SYSTEMS FOR) Confirmation No.: 8616
PROVIDING NETWORK SERVICES)
USING AT LEAST ONE)
PROCESSOR INTERFACING A)
BASE NETWORK)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

The paper is responsive to the Species Election Requirement mailed December 30, 2004, having a period for response extending to January 30, 2005. In the Election Requirement, the Examiner required election under 35 U.S.C. § 121 between ten (10) allegedly patentably distinct species (Office Action "OA" at 2). In addition to requiring election of one of the species, the Examiner required Applicants to identify the claims that are "readable thereon" (OA at 2). The Examiner asserted that claims 1 and 33 are generic to "a plurality of disclosed patentably distinct species comprising the ten (10) species set forth [in the Election Requirement]" (OA at 2, 3).

Applicants do not necessarily agree with the various characterizations and assertions set forth in the Election Requirement, including the allegedly patentably distinct species, and decline to automatically subscribe to any of those characterizations and assertions. Furthermore,

Applicants call attention to M.P.E.P. § 803, which makes clear that: “[i]f the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions” (emphasis added). While delineating ten species, the Election Requirement does not demonstrate that examining all of the alleged species would pose a serious burden on the Examiner. In fact, the Examiner provides no reasons or evidence on the record to substantiate the election of species requirement, let alone that examination of all the species would impose a serious burden.


The impropriety of the Election Requirement notwithstanding, Applicants provisionally elect to prosecute Species I, characterized by the Examiner as “firewall interfacing,” and submit that at least claims 1, 2, 33 and 49 are readable thereon. Applicants understand that upon allowance of independent claim 1 or 33, any non-elected claims depending from that allowed claim will be rejoined and considered for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 26, 2005

By: 
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Reg. No. 53,056